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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,357	12/17/2001	Andrea Michalik	2625-011763	2806

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EXAMINER

BELL, KENT L

ART UNIT PAPER NUMBER

1661

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/023,357

Applicant(s)

MICHALIK, ANDREA

Examiner

Kent L. Bell

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- papers filed 5/26/06*
- 1) ☒ Responsive to communication(s) filed on 5/26/06.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) 1 are subject to restriction and/or election requirement.

Applicant(s)

MICHALIK, ANDREA

Art Unit

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/17/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No.         .
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

*K. L. Bell*

**Detailed Action**

**Status of Application**

Applicant's response under 37 C.F.R. 1.105 filed May 26, 2006 is acknowledged.

Applicant's comments filed May 26, 2006 have been fully considered but are not found persuasive as to the issues set forth in this Office action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Page 1

**Claim Rejection**

The Claim remains rejected under 35 U.S.C. 102(b) as being clearly anticipated by Plant Breeder's Right application number 19981667 (European Union) taken in view of Applicant's admission that 'Penjul' was "sold on March 1, 1999 in Germany" (Page 2 of response filed October 7, 2002) and that "some commercial sales of 'Penjul' in Europe at the beginning of the 2000 season." had taken place (Page 2 of response filed May 26, 2006), for the reasons stated in the previous action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Response to Arguments**

Applicant's remarks filed May 26, 2006 have been fully considered but are not considered persuasive for the following reasons:

Applicant argues "The scant information available in Plant Breeders' Rights publications

**Detailed Action**

relating to 'Penjul' would not have enabled one of ordinary skill in the art to reproduce the claimed plant." The Examiner respectfully disagrees with Applicant for the following reasons:

The Examiner understands the primary contention of Applicant is that not every material element is disclosed in the primary reference (PBR 19981667). However, here, as in *In re Donohue*, the invention described in the primary reference teaches the invention but does not teach every single inherent property of the invention. It still anticipates the claim. As explained in *In re Donohue*:

"Applicant also argues that the references fail to teach the solubility characteristics melting point range set forth in dependent claims 25 and 28 respectively. However, where as here, the dicarboxylic acid TMBP and dimethyl ester TMBP of Nomura are identical to the claimed invention, the properties of Nomura's compounds are inherently the same as those of the claimed invention in the absence of proof to the contrary. See *In re Best*, 562 F.2d 1252, 195 USPQ 430.43334 (CCPA)." 226-USPQ at 622.

The claim in a plant patent application is drawn to a "plant" as described and illustrated in the specification. i.e. the claim is drawn to a plant with certain inherent characteristics. The cited Plant Breeders' Rights (PBR) document, which serves as the anticipatory reference, is drawn to the exact same plant as claimed. As a result, the PBR publication teaches each material element of the claim even if the disclosure is not detailed as an application for plant patent.

The PBR publication, together with public availability of the plant, i.e. applicant's own

the claimed inherent properties of Nomura's compounds are inherently

of proof to the contrary. See *In re*

**Detailed Action**

admission that plants of the instant cultivar were "sold on March 1, 1999 in Germany" (Page 2 of response filed October 7, 2002) and that "some commercial sales of 'Penjul' in Europe at the beginning of the 2000 season." had taken place (Page 2 of response filed May 26, 2006), would have allowed a skilled artisan to take the teachings of the Plant Breeders Right application and combine it with his own knowledge of the art to be in possession of the invention or simply obtain a plant since the plant was available (March 1999 and/or beginning of the 2000 season).

For the instant application, the plant was described in the Plant Breeder's Right application 19981667 (European Union), when combined with commercial availability in a foreign country, would have enabled one skilled in the art to reproduce the claimed invention.

**Final**

**THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Serial Number: 10/023,537  
Art Unit: 1661

Page 4

### Detailed Action

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

K. L. Bell

*Kent L. Bell*